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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/924,153	08/07/2001	Nathan G. Woodard	55114 (71850)	1475
21874	7590	04/06/2004	EXAMINER	
EDWARDS & ANGELL, LLP			FLANIGAN, ALLEN J	
P.O. BOX 55874			ART UNIT	
BOSTON, MA 02205			PAPER NUMBER	

3753

DATE MAILED: 04/06/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/924,153

Applicant(s)

WOODARD ET AL.

Examiner

Allen J. Flanigan

Art Unit

3753

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-76 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 56, 64, 67, and 74-76 is/are allowed.
- 6) ☒ Claim(s) 1-55, 59-63, 66, 68, 72 and 73 is/are rejected.
- 7) ☐ Claim(s) 57, 58, 65 and 69-71 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-42 are rejected under 35 U.S.C. 102(b) as being anticipated by Goldberg et al.

Please see the comments made in regard to the above rejection in the previous Office action. The claims have been amended by changing "heat producing device" to "bearing" in e.g. claim 1, 33, etc. This does not materially change the scope of the claims above (or patentably define over Goldberg et al.). Both "heat producing device" and "bearing" are essentially nominal recitations, implying little or nothing structurally.

"During patent examination, the pending claims must be 'given their broadest reasonable interpretation consistent with the specification.' In re Hyatt, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000). Applicant always has the opportunity to amend the claims during prosecution, and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified . . . the 'PTO applies to verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in applicant's specification . . . This means that the words of the

claim must be given their plain meaning unless applicant has provided a clear definition in the specification." MPEP 2111. The term "bearing" as defined in dictionaries and common usage is not limited to a rotatably supported structure with antifriction means, but can refer simply to a structural element that supports, or is capable of supporting, another structural element. Clearly, components 12, 44, 20, 21 shown in Goldberg et al. that are attached to flexible cables 18 are capable of supporting another component. The above claims do not positively recite that the bearing does in fact rotatably support a rotating member (*cf* claim 43).

Claims 3, 4, 22, 23, 33, and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldberg et al.

Please see the comments made in regard to the above rejection in the previous Office action.

Claims 43-49, 52-55, 59-63, 66, 68, 72, and 73 are rejected under 35 U.S.C. 102(b) as being anticipated by Richter.

Please see the comments made in regard to the above rejection in the previous Office action.

Claims 50 and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Richter.

Please see the comments made in regard to the rejection of claims 3, 4, et al. over Goldberg et al., which are equally applicable herein.

Applicant's arguments filed 2/12/04 have been fully considered but they are not persuasive.

The amendments to claim 1, 22, and 33 regarding the term "bearing" have been addressed above. Aside from the fact that the applicant's comments are based on a rather narrow definition of the claim term "bearing", the comments in regard to claims 1-42 mischaracterize the claims in asserting that they "[relate] to a heat generating device that is thermally coupled to a bearing". The claims do not in fact recite a "heat generating device that is thermally coupled to a bearing"; in fact, the added recitation "bearing" has replaced the previous recitation "heat producing device", so the applicants' arguments clearly are not commensurate with the scope of the claims.

As to Richter, the applicants' position that Richter cannot be flexible because it provides preload is untenable. One needs merely to note the springs of an automobile, which are flexible and provide preload to the suspension connection between the wheel and the vehicle, to note the erroneousess of this assertion. Richter explicitly shows and discloses a "pliable" (read: flexible) member thermally connected to a bearing rotatably supporting a member 1 that "accommodates small floating movements of the shaft both axially and radially" is readable on the "flywheel" recited in the rejected claims.

Claims 57, 58, 65, and 69-71 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 56, 64, 67, and 74-76 are allowed.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Allen J. Flanigan whose telephone number is (703) 308-1015. The examiner can normally be reached on M-F 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Scherbel can be reached on (703) 308-1272. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Allen J. Flanigan
Primary Examiner
Art Unit 3753

AJF